

Notice of Allowability

Application No.

10/529,752

Examiner

Marc S. Zimmer

Applicant(s)

WAKABAYASHI ET AL.

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 09/12/07.
2. ☒ The allowed claim(s) is/are 1-7 and 9-19.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date <u>09/12/07</u> | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

The terminal disclaimer filed on September 12, 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of a patent evolving from any one of numerous copending applications has been reviewed and is accepted. The terminal disclaimer has been recorded.

Applicant has submitted for the Examiner's consideration an additional information disclosure statement. Of the documents cited therein, JP 2001-342363 and U.S. Patent No. 6,486,289 are perhaps most germane to the invention being presently claimed. A single embodiment of the invention disclosed by the latter is one wherein a carboxylic acid and bismuth neodeconoate are incorporated. However, the bismuth compound is one of many alternatives to the favored tin-based compounds and is the ONLY one featuring carboxylate moieties wherein the carbon next to the carboxyl moiety is a quaternary carbon. Further carboxylic acids are one of only four classes of acid that are contemplated by that disclosure. A rejection under 35 U.S.C. 103 would, in the Examiner's estimation, require the benefit of hindsight, there being nothing that leads the skilled artisan to this singular embodiment in a reference that embraces perhaps thousands of different combinations of organometallic catalyst and acid compound. Finally, there is no suggestion that the carboxylic acid should be added in smaller molar quantities and, in fact, it is consistently used in higher molar quantities than is the metal catalyst in the Examples.

JP 2001-342363 discloses a moisture-curable polymer composition wherein bismuth neodeconoate is mentioned as a favored embodiment of the condensation

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catalyst. However, the reference does not teach a combination of a corresponding metal carboxylate and carboxylic acid. Rather, the system comprises said bismuth catalyst and a *reaction product derived from* a carboxylic acid (and an amine).

An updated modified survey of the prior art did not yield a reference more relevant than those already of record. Accordingly, claims 1-7 and 9-19 are allowable.

As an aside, Applicant has mentioned another application that the Examiner might consider as a foundation for a double patenting rejection. Although there does indeed appear to be some overlap in the scope of those claims, that application has a later effective filing date. Insofar as this would be the last obstacle to patentability, it is appropriate to allow this case to issue.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

October 22, 2007


MARC S. ZIMMER
PRIMARY EXAMINER